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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,833	01/05/2004	Hideyuki Sakamoto	12523/6	2508
23838	7590	06/01/2006	EXAMINER	
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			MULCAHY, PETER D	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,833

Applicant(s)

SAKAMOTO, HIDEYUKI

Examiner

Peter D. Mulcahy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The language "copolymer having a multi-layer structure" remains indefinite. Applicants point to the disclosure in the specification wherein these copolymers are described. The examiner acknowledges this description. This does not provide sufficient support so as to render the claim language definite. There is simply no way for one of ordinary skill in the art to clearly ascertain the metes and bounds of the claims. The specification provides examples of species that fall within the scope of the language but does not limit or define the claimed invention. Once again, this is not art recognized terminology and it is not sufficiently described or defined in the specification. Providing examples of suitable species is not sufficient. There is no way for one of ordinary skill in the art to identify the metes and bounds of the claimed subject matter.
4. The amendment corrected the improper multiple dependent claim language.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wanat et al. US 5,063,259 or, and in view of, Akao US 6,013,723.
7. The rejection set forth under 35 USC 103 in the paper mailed 12/14/05 is deemed proper and is herein repeated.

Response to Arguments

8. Applicant's arguments filed 3/14/06 have been fully considered but they are not persuasive.
9. Applicants point out that the claimed (meth)acrylic polymer is obtained by suspension polymerization techniques. This is contrasted with the Akao patent which shows the (meth)acrylic polymers formed with single site catalyst. The Wanat patent is alleged to show the (meth)acrylic polymers formed by bulk polymerization. This is not persuasive. The Wanat patent identifies the bulk polymerization as the preferred polymerization technique but states that the polymer can be formed by suspension polymerization, column 3, lines 35-40. The claimed (meth)acrylic polymer obtained by suspension polymerization is obvious from this disclosure. The fact that Wanat does not consider the problem associated with suspension polymerization or how containing the specific amount of a fatty acid metallic salt would solve the problem, is not germane to the patentability of the claimed invention. The alleged problem addressed by the claimed invention does not negate the obviousness of incorporating the fatty acid metallic salt for an art recognized result. The fatty acid metallic salt is a known

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functional material and known to be used in (meth)acrylic resin compositions. The incorporation of the fatty acid metallic salt into Wanat is obvious for its art recognized function.

10. The claims are directed to a resin composition. It is unclear how the composition using the suspension polymerized (meth)acrylate is patentability distinct from a resin composition formed from (meth)acrylic resins formed from bulk or continuous processes incorporating single site catalysts. The record lacks a showing of the fatty acid metallic salt in combination with the suspension polymerized (meth)acrylic resin compared with the fatty acid metallic salt used in combination with polymers formed from bulk or continuous processes incorporating single site catalysts. It is further unclear that such a showing would be probative for the claims currently of record. These are composition claims and the alleged novelty lies in the process of forming the polymer. Case law has well established that the patentability of product-by-process claims is determined by the product. In the instant case, the claimed product is not patentably distinct from the product of the prior art.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

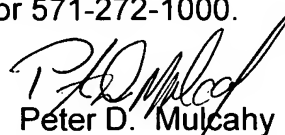
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Peter D. Mulcahy
Primary Examiner
Art Unit 1713

5/26/06